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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,394	09/08/2003	William J. Mertz	1248 P 122	9357

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EXAMINER	
MOORE, MARGARET G	
ART UNIT	PAPER NUMBER
1712	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/657,394	MERTZ ET AL.	
	Examiner	Art Unit	
	Margaret G. Moore	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 August 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 to 16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 to 16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. Claims 1 to 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "being treated with heating or optionally high velocity air" is confusing. The term "or" indicates that the coating is treated in the alternative with either heating or high velocity air. The presence of "optionally" indicates that treatment with high velocity air is optional. It is the presence of "optionally" after "or" that renders this claim confusing. On one hand it appears that some type of treatment step occurs. On the other hand, since treatment with high velocity air is the alternative to heating and since this step is optional, it appears that no type of treatment step is required. Clarification is required.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 to 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Leir et al. for reasons of record.

The teachings of Leir et al. and how they apply against the instant claims have been addressed in previous office actions and as such this will not be repeated. Applicants' traversal is not persuasive.

The bulk of applicants' traversal involves the position that the reactive diluent in Leir et al. is not an organic solvent. The Examiner disagrees. She notes that claims must be given their broadest reasonable interpretation and there is nothing in the claims that would distinguish the organic solvent from a reactive diluent. The Examiner notes, for instance, that page 6 of the specification indicates that the solvent selection is quite broad and is non-limited by any of the exemplified solvents. The Examiner also notes that the specification indicates that the organic solvent disperses or dissolves the silicone release coating; the solvent is not even limited by one which dissolves. On the other hand, note that the compositions in Leir et al. that use the reactive diluent refer to

the composition as a solution. See for instance column 16, line 26. There simply is nothing to distinguish the two components.

Applicants state that the organic solvent has a lower boiling point than the reactive diluents described in Leir. This position is not persuasive for two reasons. First, most of the claims do not require any specific boiling point. Second, see the attached definition of limonene, which is one of the reactive diluents used in Leir et al. It has a boiling point of approximately 176°C. In fact Example 34 heats the coated surface to a temperature that is higher than the boiling point of limonene which will result in at least some removal. Again the Examiner notes that the temperature in this example is within the range of claim 12.

In summary, applicants again note that they are of the belief that the heating step is what results in a product having low levels of extractables (last two lines of page 6 of the remarks) and since the prior art shows heating and high velocity air treatment, it would follow that the resulting liner in Leir et al. inherently meets the extractable and volatile content limitations.

4. Claims 1 to 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Eckberg et al. '480.

This reference was cited in the previous office action, though not applied against the claims. Eckberg et al. teach a radiation curable silicone composition used to form a release coating. The instant claims require that the silicone release coating composition be treated to heat or optionally high viscosity air to result in a coating composition that has a reduced amount of silicone extractables and volatile silicone compounds. While this reference lacks specific reference to the final silicone extractable and volatile content, column 6, lines 19 and on, teach treating the release coating composition to devolatilization by using a combination of heat and high velocity air to reduce low molecular weight siloxanes. This is the same treating step relied upon by applicants to arrive at their required silicone content. Note for instance Example 1 which treats the silicone composition to stripping at a temperature within the range of claim 12. Since the treating step in the claims results in the final silicone content, it will correspondingly

result in the same silicone content,as claimed. Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection. See MPEP 2112 (III).

While the reference to release coatings in Eckberg et al. does not specifically mention applying the composition with a solvent (column 6, line 51), since the solvent is driven off it does not appear that this requirement in the product by process claims will result an inherently different product. Note for instance that any amount of solvent can be present in the coating composition that is applied such that as little as, for instance, 1% by wt. of solvent is all that is required.

5. Claims 1 to 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Eckberg et al. '453.

Eckberg et al. '453 incorporates by reference the teachings in Eckberg et al. '480 as to the preparation of the epoxy siloxane therein. See column 8, line 53, and column 3, line 67. Thus the treatment of the radiation curable silicone coating composition to remove silicone extractables and volatiles is present in Eckberg et al. '453. Note too column 8, line 67, through column 9 which discloses heating and removing by vacuum distillation the solvent and "light ends". While this does not specifically teach the resulting silicone content required by the claims, since the process by which the compositions are treated are the same, it will follow that the resulting composition properties will also be the same. Note, for instance, that the treating temperature is the same as that in claim 12. Note too that applicants admit that it is the heat treatment step that results in the required silicone content.

This composition is admixed with a solvent and used to form a release coating composition. In this manner the instantly claimed release liner appears to be inherently the same as that produced by Eckberg et al.

6. Applicants' response refers to the above cited Eckberg et al. references. They state that Eckberg would not result in the same product as the present invention since the devolitization process described in Eckberg is not efficient enough to remove the low molecular weight cyclics to meet the extractable levels referred to in the present invention. Since the process steps by which the claimed product is prepared is the same as the process steps in Eckberg, however, the Examiner cannot accept applicants' assertion as fact.

Please note that "The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
9/10/07